

REMARKS

Status of the Claims

Claims 15-23 are currently pending in the above-identified application. No claims have been canceled or added in this paper. Claims 1-14 were previously canceled in the preliminary amendment. Claim 15 has been amended to recite the correct name of the thienyl represented by R¹. Claim 19 has been amended to delete the abbreviation "Ach" and insert "acetylcholine". Claim 19 has also been amended to define the compound as having agonistic activity. Support is found at page 5, line 26. Claim 23 has been amended to change dependency from claim 22 to claim 20. Applicants submit that no new matter has been added by the above claim amendments.

Priority/Objection to the Specification

The Examiner states that the specification must be amended to reflect that the above referenced application is a divisional of 09/450,637. Applicants submit that such a reference was made in a Preliminary Amendment filed on July 17, 2003, where the specification was amended to reference U.S. Patent Application serial number 09/450,637. However, Applicants submit a new amendment to the specification to update the status of the parent case by providing the patent number. As such, Applicants respectfully request that this objection be withdrawn.

Rejection under 35 USC 112, second paragraph

The Examiner rejects claim 19 as indefinite because the claim recited a "modulator" and did not define if the modulator was an agonist or antagonist. The Examiner stated it was not clear of how the compound functions. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants amend claim 19 to recite that the modulator is an agonist. Applicants submit that it is routine work for the skilled artisan to determine if the compound functions as an agonist or antagonist in treating specific complications using standard functional assays described in the art. Applicants submit herewith three references (Amar et al., Gopalakrishnan et al. and Albuquerque et al.), all of which were available at the time the present application was filed, which describe how one is able to determine if a compound has agonistic or antagonistic activity. (Exhibits A, B and C attached hereto).

Rejections under 35 USC 112, first paragraph

The Examiner rejects claims 15 and 17-23 as containing subject matter not described in the original disclosure. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the recitation of 2-(3-methoxymethyl) in claim 15 is a clerical error. Applicants amend claim 15 to correctly recite that R¹ is 2-(3-

methoxymethyl)thienyl. Support for 2-(3-methoxymethyl)thienyl is found in the original disclosure at page 8, lines 22-23. As such, this rejection should be withdrawn.

The Examiner also rejects claims 19-23 as not enabled by the specification. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the present invention is enabled by the specification. Applicants amend claim 19 to recite that the compound acts as an agonist. Applicants also submit herewith Exhibits A, B and C to support enablement for claim 19. Applicants submit that Exhibits A-C disclose assays for determining if a compound has agonistic or antagonistic activity in treating a particular complication. One of ordinary skill in the art could arrive at the present invention as recited in claim 19 from the disclosure in the specification teaching how to make and use the compound, particularly in conjunction with the knowledge known in the art for how to determine if the compound has agonistic or antagonistic function. As such, Applicants submit that this rejection should be withdrawn.

Obviousness-Type Double Patenting Rejections

The Examiner rejects claims 15-23 under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of USP 6,645,977. Applicants file concurrently herewith a terminal disclaimer, disclaiming the terminal portion of any patent that may issue from the above-identified

application so that the term will not exceed the term of USP 6,645,977. As such, this rejection should be withdrawn.

The Examiner also provisionally rejects claims 15-23 under the judicially created doctrine of obviousness type double patenting over claims 18-20 of co-pending application 10/380,653. Applicants submit that since this rejection is a provisional rejection, Applicants elect to file a terminal disclaimer, if necessary, upon the allowance of the later application. As such, Applicants respectfully request that this rejection be withdrawn.

Information Disclosure Statement

Applicants respectfully request that the Examiner consider the Information Disclosure Statement submitted on August 22, 2003 and initial the Form PTO 1449 and return a copy of the initialed form to the undersigned below.

Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

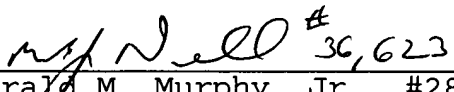
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia J. Reynolds (Reg. 47,021) at the telephone number of the undersigned below.

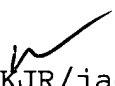
Appl. No. 10/620,559

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Terminal Disclaimer

Exhibits A, B and C